

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CHARLES K. WIKE, JR.,  
ROBERT L. SNYDER, ALFRED JOHN HUTCHEON,  
DANIEL F. JAMES and PAUL F. NUGENT, JR.

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Appeal No. 2005-2051  
Application No. 10/001,389

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ON BRIEF

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Before RUGGIERO, DIXON, and GROSS, Administrative Patent Judges.  
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-20, which are all of the claims pending in the present application.

The claimed invention relates to a self-service checkout terminal system and method in which a user scans an item for purchase via a scanner. After a successful scan, a determination is made as to whether the scanned item includes an active electronic article surveillance (EAS) tag. Upon a determination

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that the scanned item includes an EAS tag, the user is directed to deactivate the EAS tag. According to Appellants (Specification, Abstract), the EAS detection system of the invention eliminates the need to use a deactivation procedure for every purchased item, thereby streamlining a retail store checkout process.

Claim 1 is illustrative of the invention and reads as follows:

1. A method of operating a self-service checkout terminal comprising the steps of:  
allowing consumer scanning of an item for purchase via a scanner;  
determining, after successfully scanning the item, whether the item has an active electronic article surveillance tag; and  
allowing deactivation of the active electronic article surveillance tag by the consumer via an active electronic article surveillance tag deactivator after determining that the item has an electronic article surveillance tag.

The Examiner relies on the following prior art:

Bergman et al. (Bergman)	5,469,142	Nov. 21, 1995
Swartz et al. (Swartz)	5,594,228	Jan. 14, 1997
Garber et al. (Garber)	6,486,780	Nov. 26, 2002 (filed Jul. 19, 2000)
Bellis, Jr. et al. (Bellis) Published U.S. Patent Application)	2002/0096564	Jul. 25, 2002 (filed Jan. 19, 2001)

Claims 1-20, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a). As evidence of obviousness,

the Examiner offers Swartz in view of Bergman with respect to claims 1-4, 8, 9, 15, and 16, adds Bellis to the basic combination with respect to claims 5-7, 10-12, and 17-19, and adds Garber to the basic combination with respect to claims 13, 14, and 20.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs<sup>1</sup> and Answer for the respective details.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the

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<sup>1</sup> The Appeal Brief was filed May 20, 2004. In response to the Examiner's Answer mailed November 2, 2004, a Reply Brief was filed December 6, 2004, which was acknowledged and entered by the Examiner as indicated in the communication mailed February 10, 2005.

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particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-20. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.

Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claims 1, 8, and 15 based on the combination of Swartz and Bergman, Appellants assert that the Examiner has failed to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

We agree with Appellants that, although the Examiner has cited the Bergman reference as providing a teaching of the claimed electronic article surveillance detector (EAS), proper motivation for the proposed combination with Swartz has not been established. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

As pointed out by Appellants (Brief, pages 6-8; Reply Brief, pages 4 and 5), the system of Swartz has no need for the EAS detector taught by Bergman since Swartz's system presumes a surveillance tag is present, the tag being uniquely identified and associated with a purchased item. We also agree with Appellants that the Examiner's suggested (Answer, page 7) motivating factor for the proposed addition of the EAS detector of Bergman to Swartz, i.e., to assure in the system of Swartz that a surveillance tag is deactivated, is without merit. It is apparent from our review of Swartz, there is no need for any such determination as to whether a surveillance tag has been deactivated in Swartz since it is already known that a tag has not been deactivated when a surveillance tag is presented for deactivation. In our view, given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellants' own disclosure and not from any teaching or suggestion in the references themselves.<sup>2</sup>

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<sup>2</sup> We make the observation that the Swartz reference discloses (column 8, lines 36-39, column 10, line 36, and column 19, lines 51-54) a situation in which a user, after successfully scanning and purchasing an item, attempts to leave a store without deactivating the surveillance tag thereby triggering an alarm requiring such user to retreat back to a deactivation area for

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We have reviewed the Bellis and Garber references applied by the Examiner to address the scale/bagwell and EAS detector circuitry features, respectively, of various dependent claims. We find nothing, however, in the Bellis and Garber references, which would overcome the innate deficiencies of Swartz and Bergman discussed supra.

Accordingly, since we are of the opinion that the Examiner has not established a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references, we do not sustain the rejection of independent claims 1, 8, and 15, nor of claims 2-7, 9-14, and 16-20 dependent thereon.

In summary, we have not sustained the Examiner's 35 U.S.C. § 103(a) rejection of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-20 is reversed.

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deactivation of the surveillance tag. We leave it to the Examiner to consider whether the triggering of an alarm would be considered a determination as to whether a purchased item has an active surveillance tag which then "allows" a user to then deactivate the surveillance tag as recited, for example, in appealed claim 1.

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REVERSED

*Joseph F. Ruggiero*

JOSEPH F. RUGGIERO  
Administrative Patent Judge

*Joseph L. Dixon*

JOSEPH L. DIXON  
Administrative Patent Judge

*Anita Pellman Gross*

ANITA PELLMAN GROSS  
Administrative Patent Judge

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